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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/631,257	07/31/2003	Yun Xin Li	CML00843AC	1623
22917	7590	10/20/2008	EXAMINER	
MOTOROLA, INC.			CHRISS, ANDREW W	
1303 EAST ALGONQUIN ROAD				
IL01/3RD			ART UNIT	PAPER NUMBER
SCHAUMBURG, IL 60196			2419	
			NOTIFICATION DATE	DELIVERY MODE
			10/20/2008	ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

Docketing.US@motorola.com

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/631,257	LI ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Andrew Chriss	2419	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 9/12/2008.

2a) This action is **FINAL**.                            2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-25 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1-25 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on 31 July 2003 is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.

4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.

5) Notice of Informal Patent Application

6) Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Response to Amendment***

1. Applicant's amendment, filed September 12, 2008, has been entered and carefully considered. Claim 5-7, 9, 10, 12, 13, 15, 18, 19, 21, 22, 24, and 25 are amended, and Claims 1-25 are currently pending.
2. Rejection of Claims 5-7, 8, 9, 12, 13, 15, 18, 19, 21, 22, 24, and 25 rejected under 35 U.S.C. 112, second paragraph, is withdrawn in light of Applicant's amendment.

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.
2. **Claims 1-25** rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claims contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Independent Claims 1 and 17 respectively cite "obtaining pre-defined modulated transmission protocol bits stored in a memory" and "a memory storing pre-defined modulated transmission protocol bits." The claim language requires that the pre-defined transmission protocol bits are already modulated as they are stored in the memory. However, Applicant's specification does not describe how said transmission protocol bits are modulated prior to being stored in said memory. The step of modulation requires "varying some characteristic of the electrical carrier wave as the information

*to be transmitted* on that carrier wave varies" (emphasis added). There is no disclosed step of modulating the pre-defined transmission protocol bits, nor a disclosed feature that would show how a modulated signal could be stored. Therefore, Applicant's disclosure would not enable one skilled in the art to make and use that defined by the claims of the instant application. Claims 2-16 and 18-25 depend on the independent claims cited above and fail to resolve the deficiencies therein.

### ***Response to Arguments***

3. Applicant's arguments filed September 12, 2008 regarding rejection of Claims 1-25 under 35 U.S.C. 112, first paragraph, have been fully considered but they are not persuasive. Per MPEP 2164.05: "To overcome a *prima facie* case of lack of enablement, applicant must demonstrate by argument and/or evidence that the disclosure, as filed, would have enabled the claimed invention for one skilled in the art at the time of filing." In order to overcome the *prima facie* case of lack of enablement established in the Office Action mailed September 3, 2008, Applicant states "on page 10 lines 6-7 it is stated that the invention "alleviates the need to continuously modulate, filter and shape known, non-variable data independent preamble and header protocol bits". The known, non-variable data independent preamble and header protocol bits are the pre-defined modulated transmission protocol bits that are described in the specification (page 7 line 28 to page 8 line 15). It is well known that modulated signals can be simulated, or observed (for instance on a spectrum analyser or oscilloscope) or digitally stored. Hence, the pre-defined modulated transmission protocol bits can be easily obtained for instance by simulation or by actually modulating the limited number of possible protocol transmission bit sequences and then

storing the modulated bits for future use.” Examiner notes that the above argument does not overcome the *prima facie* case of lack of enablement. Defining the term “pre-defined modulated transmission bits” in the specification does not constitute an enabling disclosure. The provided example of a spectrum analyzer and oscilloscope for observing a modulated signal is not sufficient evidence that modulated bits can be stored. Applicant does not provide any arguments or evidence that the disclosure, as filed, would have enabled one of ordinary skill in the art at the time of filing to make and use the invention, as required by 35 U.S.C. 112, first paragraph, and MPEP 2164.05 above. Rejection of Claims 1-25 under 35 U.S.C. 112, first paragraph is therefore maintained.

### ***Conclusion***

4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andrew Chriss whose telephone number is (571)272-1774. The examiner can normally be reached on Monday - Friday, 7:30 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hassan Kizou can be reached on 571-272-3088. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Andrew Chriss  
Examiner  
Art Unit 2419  
10/11/2008

/Hassan Kizou/  
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